

In re Appln. of Uytterhoeven et al.
Application No. 09/934,806

The Amendments to the Claims

The claims have been amended to point out more particularly and claim more distinctly the subject matter of the invention. In particular, claim 5 has been amended to recite that the first aqueous dispersion is obtained by a preparation process according to claim 1. Moreover, claim 11 has been amended to recite that the fourth aqueous dispersion is obtained by a preparation process according to claim 8. Claims 14 and 15 have been added to claim photothermographic recording materials in accordance with the present invention. Support for the newly added claims can be found at pages 10-11. No new matter has been added by way of these amendments. Separate documents setting forth (a) the precise changes to the specification and the claims, as well as (b) the text of all of the pending claims, are enclosed herewith.

Information Disclosure Statement

Applicants have submitted herewith a Supplemental Information Disclosure Statement. Applicants respectfully request that the Examiner indicate consideration of the references listed on the enclosed PTO-1449 Form by initializing the PTO-1449 Form next to each reference. Moreover, Applicants respectfully request that the Examiner indicate consideration of Doc. No. AC (Search report for EP 00 20 3137 dated February 20, 2001), which is listed on the previously submitted form PTO-1449.

Summary of Office Action

The Office Action rejects claims 5-6 and 11-12 under 35 U.S.C. § 102(b) as allegedly anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Gilliams et al. (i.e., U.S. Patent 5,891,616). (hereinafter "Gilliams"). Applicants acknowledge, with appreciation, the indication that claims 1-4, 7-10, and 13 are allowable.

Discussion of the Anticipation and Obviousness Rejections

The anticipation and obviousness rejections are not believed to be proper inasmuch as the cited reference (i.e., Gilliams) does not disclose nor reasonably suggest the present inventive aqueous dispersions.

The Office, in support of its position, contends that Gilliams discloses an aqueous dispersion containing a silver salt of an aliphatic carboxylic acid and a silver halide. (Office Action, page 2). Although the Office states that "Gilliam may not discloses [sic] the process of adjusting PH [sic] of the aqueous solution while mixing silver halide and silver salt of an organic carboxylic acid," the Office nevertheless concludes that the composition thereof is "the same or similar." (Office Action, page 2). Moreover, the Office, citing *In re Thorpe*, 777 F.2d 695, 698, 227 U.S.P.Q. 964, 966 (Fed. Cir. 1985), contends that "[t]he patentability of a product does not depend on its method of production." (Office Action, page 2).

The Office's rejection with respect to claims 5-6 is necessarily predicated on the assumption that the inventive process recited in claim 1 has no effect on the properties of an aqueous dispersion prepared in accordance with that process. Likewise, the Office's rejection with respect to claims 11-12 is necessarily predicated on the assumption that the inventive process recited in claim 8 has no effect on the properties of an aqueous dispersion prepared in accordance with that process.

The inventors, however, have unexpectedly discovered that photothermographic recording materials coated with the aqueous dispersions of the present invention unexpectedly exhibit a substantial reduction in background density and an improvement in the stability of background density (without "the necessity for lengthy conditioning at elevated temperatures and high relative humidities") (see the paragraph bridging pages 2-3 of the instant specification). Since the dispersions disclosed in Gilliams are not prepared in accordance with any of the present inventive processes, it cannot be said that those dispersions have the properties achieved by means of such preparation. Moreover, Applicants point out that Invention Examples 1-6 and Comparative Examples 1 and 2 of the present application demonstrate that the properties of a photothermographic recording material having a thermosensitive element coated with a present inventive aqueous dispersion differ from those of a photothermographic recording material not employing such a dispersion (at least with respect to the stability of in the dark of their sensitivity and with respect to Dmin upon exposure and thermal development).

As regards claims 14-15, Applicants respectfully submit that the photothermographic materials recited therein are novel and unobvious, as evidenced by Invention Examples 1-6 and Comparative Examples 1 and 2 of the present application.

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Since none of the cited references discloses or fairly suggests the present invention as recited in pending claims, nor the attendant unexpected advantages relating thereto (e.g., as reflected in the instant specification at pages 2-3 and in Invention Examples 1-6), the present invention is patentable over the cited reference. Accordingly, the anticipation and obviousness rejections should be withdrawn and the application allowed.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Salim A. Hasan, Reg. No. 38,175
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

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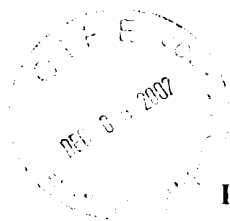
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CERTIFICATE OF MAILING

I hereby certify that this AMENDMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231,

Date: 12/5/02 V. G. S. H. K.

M:/Clients/Agfa Gevaert/U.S. Prosecution/Amd/212967amdt



PATENT
Attorney Docket No. 212967
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Uytterhoeven et al.

Application No. 09/934,806

Filed: August 22, 2001

Art Unit: 1752

Examiner: T. Chea

For: AQUEOUS DISPERSION COMPRISING
PHOTOSENSITIVE SILVER HALIDE AND
A SUBSTANTIALLY LIGHT-INSENSITIVE
SILVER SALT OF AN ORGANIC
CARBOXYLIC ACID

**AMENDMENTS TO CLAIMS
MADE IN RESPONSE TO OFFICE ACTION DATED JULY 2, 2002**

Amendments to existing claims:

5. (Amended) A first aqueous dispersion comprising an ex-situ photosensitive silver halide and a substantially light-insensitive silver salt of an organic carboxylic acid [obtainable] obtained by a preparation process according to claim 1.

11. (Amended) A fourth aqueous dispersion comprising a second in-situ photosensitive silver halide and a substantially light-insensitive silver salt of an organic carboxylic acid [obtainable] obtained by a preparation process according to claim 8.

14. (New) A photothermographic recording material comprising a photo-addressable thermally developable element, wherein the photo-addressable thermally developable element comprises a layer produced with a first aqueous dispersion, wherein the first aqueous dispersion comprises an ex-situ photosensitive silver halide and a substantially light-insensitive silver salt of an organic carboxylic acid, and wherein the first aqueous dispersion is obtained by a preparation process according to claim 1.

15. (New) A photothermographic recording material comprising a photo-addressable thermally developable element, wherein the photo-addressable thermally developable

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element comprises a fourth aqueous dispersion comprising a second in-situ photosensitive silver halide and a substantially light-insensitive silver salt of an organic carboxylic acid and wherein the fourth aqueous dispersion is obtained by a preparation process according to claim 8.